

REMARKS

Claims 1-24 are all the claims presently pending in the application. Claims 22-24 are added. Support for new claims 22 and 23 is found in paragraphs [0069-0081] of the specification. Support for new claim 24 is found at lines 16-17 of page 1 of the specification (e.g., paragraph [0005]).

It is noted that the claim amendments, if any, are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 18 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite, because, according to the Examiner, the “said event” of the first claim limitation lacks antecedent basis. In response, Applicants submit that the preamble provides the necessary antecedent basis, but have decided to amend the claim in an attempt to expedite prosecution and request that the Examiner reconsider and withdraw this rejection.

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent Publication No. 2002/0143469 to Alexander, et al., further in view of US Patent No. 6,985,872 to Benbassat et al. Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander/Benbassat, further in view of the Examiner's Official Notice.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

As described in, for example, independent claim 1, the claimed invention is directed to a method of calculating a risk exposure for a disaster recovery process. A user interface is loaded into a memory, the user interface allowing control of an execution of one or more risk models, each of the risk models based on a specific disaster type, each risk model addressing a recovery utilization of one or more specific assets identified as necessary for a recovery process of the disaster type. One of the risk models is executed at least one time.

As described beginning at line 10 of page 1 of the specification, the conventional disaster recovery service, as referring to a business that provides computer facilities to

contracted customers who seek recovery services following a disaster, currently has no known methods to estimate the frequencies that disaster will strike its clients and how often such customers will declare a disaster.

The claimed invention, on the other hand, provides an objective method for estimating such risks, including an objective manner to plan location and amounts of assets at recovery centers.

II. THE PRIOR ART REJECTIONS

The Examiner alleges that Alexander, as modified by Benbassat, renders obvious the claimed invention. Applicants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by either Alexander or Benbassat.

The Alexander Reference

Primary reference Alexander, et al., describes a method for collecting data in real time from multiple locations after a disaster event has occurred, integrating the data into a geographical database, and using the data and database to assess damage and to support decision making by emergency management agencies in response to a disaster event.

This is a very different application from that of the claimed invention.

Specifically, Alexander deals with "disaster recovery" as a single episode of recovery after a disaster has occurred, while the present invention is concerned with the continuous operation of a "disaster recovery service", as is clearly defined in paragraph 5 of the specification. As will become apparent, primary reference Alexander actually has very little in common with the claimed invention.

Perhaps most relevant to the claim language, nothing in Alexander is relevant to "calculating a risk exposure." In the claimed invention, calculating a risk exposure specifically involves carrying out statistical analyses on historical data prior to the occurrence of a disaster event (e.g., see claims 13, 17, 18, and 19, along with new claims 22 and 23). None of these elements (e.g., "statistical analysis", "historical data", or performing any analysis "prior to the disaster event") are present in the method of Alexander.

Stated slightly differently, even disregarding the fundamental distinction that Alexander is not related to a disaster recovery service, the method of Alexander most that one can reasonably allege is that the method of this reference might well be useful to accumulate data for a disaster event, but there is no suggestion of subsequently carrying out analysis of this disaster data, as would be done in the method of the present invention, to derive a

statistical model that could then be selectively executed repetitively to calculate a risk exposure. Along this line, the type of disaster information described in Alexander does not even appear to be oriented to determination of the nature of the risks as more particularly described in new claims 22 - 24, without drastic modification to change the orientation of Alexander toward the problem being addressed by the present invention.

In the rejection of record for independent claim 1, the Examiner alleges that primary reference Alexander is deficient only in its failing for “ … allowing control of an execution of one or more risk models, each said risk model being based on a specific disaster type, each said risk model addressing a recovery utilization of one or more specific assets identified as necessary for a recovery process of said disaster type; and executing, at least one time, one of said risk models”, and introduces secondary reference Benbassat to overcome these deficiencies.

The Reference Benbassat

Secondary reference Benbassat describes a system for assigning human resources to service tasks. Statistical methods are used to forecast demand for services, and simulation of hypothetical scenarios of daily demands is used "to achieve more accurate predictions" (Benbassat, column 10, lines 38-39). It is also asserted that the simulated scenarios will "reveal conditions that may create problems in the future" (Benbassat, column 11, lines 2-3).

Benbassat mentions risk (column 1, lines 34-37), but only in passing: "allocating too few resources results in ... risking losing customers". The risk of losing customers is not among the risks with which the risk models that the claimed invention are concerned.

More significant, Benbassat does not include anything that could be regarded as a "risk model", i.e., a model that calculates the frequency and estimates the consequences of unusual and extreme adverse events, the definition that is embodied by the "specifications" in paragraphs [0069-0070] of the present application. Indeed, Benbassat explicitly states that forecasts and simulations are of "a *typical* day's demands" (column 10, line 52; my emphasis).

Benbassat (e.g., at column 10, lines 41-55) describes a method that includes simulating scenarios of future claims on resources. At a high level of generality, the present invention might arguably be similar at some level of abstraction, but the claimed invention uses none of Benbassat's specific components (scheduling module, forecasting module, planning module, analysis module). Therefore, it cannot reasonably be alleged that it one

having ordinary skill in the art would have been motivated to modify Alexander by the method of Benbassat to arrive at the claimed invention.

In the rejection of record, the Examiner alleges that "*The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.*"

In response, Applicants submit that the fundamental flaw in the Examiner's above-recited conclusory statement is that it fails to properly convey the proper obviousness analysis. The appropriate analysis should begin by identifying the differences between primary reference Anderson and the claimed invention and then identifying how secondary reference Benbassat overcomes these deficiencies.

More specifically addressing the Examiner's above-recited allegations, Applicants submit that the claimed invention involves more missing elements than those identified by the Examiner and submit that, even if "only" old elements are involved in the claimed invention, the combination defined by the claims constitutes a new combination of these elements that is not suggested even if Alexander and Benbassat were to be somehow combined, particularly in view of their different purposes and principles of operation.

As noted above, Applicants respectfully disagree completely with the Examiner's characterization that primary reference Alexander has anything whatsoever that is reasonably related to calculating a risk exposure for a disaster recovery process, since it has the entirely different purpose of an automated gathering and integrating of field information related to a current emergency. There is no suggestion in Alexander to calculate a risk exposure or even a suggestion that the integrated data could be used for a risk exposure calculation, and the rejection of record makes no attempt to identify any discussion in Alexander for such purpose of its data. Thus, the only similarity with the claimed invention described by independent claim 1 is that of the user interface in Alexander. Alexander relates only to accumulating data for a single emergency and has nothing whatsoever to do with even calculating a risk exposure for even that emergency event, let alone executing risk models for specific disaster types.

Thus, primary reference Alexander differs completely from the claimed invention of claim 1. Applicants submit that, in order to modify Alexander to satisfy the plain meaning of the claim language of even claim 1, the Examiner would have to provide a reasonable rationale to:

- Convert Alexander into a method of calculating risk exposure for a disaster recovery process, rather than merely gather and integrate data for a single emergency;
- Introduce risk models for specific disaster types, a concept not even currently present in Alexander (or even suggested in either of Alexander or Benbassat); and
- Execute the risk models.

From these necessary modifications, it is clear that primary reference Alexander has a

completely different purpose and principle of operation from that of even independent claim

1. Such change in principle of operation to arrive at the claimed invention is clearly improper hindsight and is not permitted, as clearly stated in MPEP §2143.01, describing the holding of *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959): “*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.*”

Moreover, the elements identified above by Applicants as missing from even independent claim 1 are not elements taught in secondary reference Benbassat, let alone elements recognized as being either substitutes or improvements of Alexander. That is, because of its entirely different purpose, primary reference Alexander does not require any of these missing elements to achieve its purpose and would not benefit in any way from their incorporation.

Hence, turning to the clear language of the claims, in Alexander there is no teaching or suggestion of: “A method of calculating a risk exposure for a disaster recovery process, said method comprising: loading a user interface into a memory, said user interface allowing control of an execution of one or more risk models, each said risk model being based on a specific disaster type, each said risk model addressing a recovery utilization of one or more specific assets identified as necessary for a recovery process of said disaster type; and executing, at least one time, one of said risk models”, as required by independent claim 1. Independent claims 10 and 12 have similar language. Accordingly, claims 1-10 and 12 are clearly patentable over Alexander.

Relative to the rejection of record for claims 8, 9, 13, 18, the claimed invention uses a plurality of runs of the risk model, each run using parameter(s) selected at random. Such feature is not present in primary reference Alexander and would defeat the purpose of this primary reference. Therefore, this feature cannot be incorporated into Alexander, under the

holding of *In Re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), as described in MPEP §2143.01: “*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.*”

Relative to the rejection for claims 20 and 21, the Examiner invokes Official Notice, alleging that “advertising a product was old and well known to a person of ordinary skill in the art....” However, merely “advertising a product” does not satisfy the plain meaning of the claim language of claim 20. That is, this claim requires: “... advertising that said disaster recovery service utilizes said tool as a technique to control an inventory of said assets.” Therefore, the Examiner invocation of Official Notice is not sufficient to demonstrate this claim, and Applicants request that the Examiner provide of record a combinable reference that demonstrates the plain meaning of this claim language.

Relative to the rejection for claim 21, the description at lines 4-11 of column 2 of secondary reference Benbassat has nothing to do with contracts or with offering price point differentials.

In summary, Applicants submit that the rejection of record for even independent claim 1 has the following errors of fact:

1. The examiner asserts that "Alexander teaches a method of calculating a risk exposure". This is factually incorrect: as noted above, nothing in Alexander has anything to do with calculating risk exposure.
2. The examiner further asserts that the said method of calculating a risk exposure is "for a disaster recovery process". This is not relevant: as noted above, the "disaster recovery process" of Alexander is very different from the "disaster recovery service" of the present invention.
3. The examiner acknowledges that Alexander fails to teach "execution of one or more risk models ... ", but asserts that this is contained in Benbassat. This is factually incorrect: as noted above, Benbassat does not include anything that could be regarded as a risk model.
4. The examiner asserts that it would have been obvious to one of ordinary skill in the art to combine the teachings of Alexander and Benbassat. This is clearly incorrect, since the subject areas of these two references are very different both from each other and from the subject area of the present invention. Furthermore, neither Alexander nor Benbassat teaches the calculation of a risk exposure, so combining Alexander and

Benbassat still does not yield all the content of the claimed invention.

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggested by Alexander. Therefore, the Examiner is respectfully requested to withdraw these rejections.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-24, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via EFS this Amendment under 37 CFR §1.111 to the USPTO on Monday, November 24, 2008.



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